

REMARKS/ARGUMENTS

Claims 1-17 are currently pending in the application. Reconsideration of the application is respectfully requested.

Claims 1-17 stand rejected as being unpatentable over U.S. Patent No. 6,183,158 to Lynton in view of U.S. Patent No. 6,045,161 to Ashcroft et al. This rejection is respectfully traversed for the following reasons.

According to the Office action, Lynton discloses a binder insert comprising a transparent plastic bag-shaped body with an open upper side, a plurality of store portions which can store photographs, memos, etc. and a binding section having holes. The Office acknowledges that Lynton fails to disclose a store board comprising thick paper folded in two and having slits at a predetermined location, color paper between facing surfaces of the thick paper, slits in various shapes and slits to hold photographs on an outside surface of the thick paper. The Office action relies on Ashcraft et al. for teaching a store board comprising thick paper folded in two with a set of slits at a predetermined location and color paper disposed between the thick paper surfaces. According to the Office action, it would have been obvious to modify Lynton's binder insert to include a store board comprising folded paper having slits and color paper disposed therein for the purpose of "mounting indicied substrate(s) in a stable position between the folded store board, so as to prevent movement of the substrate(s)." Office action, page 3-4.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to the claims of the pending application because the documents cited by the examiner, considered either individually or in combination, fail to disclose each and every element of the claim structure. Furthermore, the proposed motivation for modifying the references or combining the references fails to satisfy the requirement for a clear and particular motivation to combine the references.

The documents cited by the examiner fail to disclose or suggest a binder insert containing a memo store portion and a photograph store portion as set forth in the claims of the pending application. The Office relies on the broad statement in Lynton that the flexible sheet protector may comprise two or more receiving pockets and the broad description of "contents" to include

prints, paper, paperboard, etc. to arrive at the conclusion that Lynton discloses a binder sheet comprising a memo store portion and a photograph store portion. However, applicants respectfully submit that the broad disclosure is insufficient to indicate why one of skill in the art would pick and choose from all of the disclosed possibilities for the contents and use of a plurality of pockets to arrive at a binder sheet containing a photograph store portion and a memo store portion as set forth in the claims of the pending application. Furthermore, the Office fails to provide any motivation for this modification of the Lynton protective cover to obtain the applicant's construction. It is insufficient to simply identify broad disclosures in the cited document and indicate that the protective cover could be modified to include two pockets, one of which is for photographs and the other which is for memos. Accordingly, the cited documents fail to disclose or suggest a memo store portion and a memo inserted therein as presently set forth in claim 1 or a memo store portion as set forth in claim 17. Therefore, for at least this reason, applicants respectfully submit that the documents fail to disclose this element of the claim structure and therefore the obviousness rejection must fail as a matter of law.

The Office also provides a quote from the '158 reference which indicates that Lynton discloses that the term "contents" includes store boards. However, applicants respectfully submit that the cited passage in the '158 reference refers to paperboard and not store board and that the two terms are not interchangeable.

Applicants addressed Ashcraft in our previous response and provided reasons as to why the Office's reliance on Ashcraft was misplaced. Applicant's arguments with respect to Ashcraft were not addressed in the May 20, 2004 Office action and, therefore, applicants repeat the substance of those arguments herein. If the arguments contained herein are not deemed to be persuasive, applicant requests that such reasons be articulated so that applicant may have an opportunity to fully respond.

The Office action further indicates that Ashcraft discloses a color paper (34) disposed between the thick paper surfaces of a store board 36. Applicants respectfully submit that Ashcraft fails to disclose either of these elements of the present invention. Element 36 of Ashcraft is a support sheet which includes tabs 44 for supporting display sheet 38. However, external frame 42 although integrally formed with the support sheet 36 is a frame and not a store

board. There is no way of storing a photograph or other item on the frame 42. Although Applicants maintain that claim 1 is clearly distinguishable over the Ashcraft reference for this reason, claim 17 has been added to recite additional distinctions over the Ashcraft reference. Likewise, element 34 in Ashcraft is the tab assembly including the support sheet 36, display sheet 38, internal frame 40 and external frame 42. In other words, the support sheet 36 is a part of the tab assembly 34 and, therefore, it is not possible for the tab assembly 34 to be disposed between the thick paper surfaces of the support sheet. Therefore, for at least this reason as well, Applicants respectfully submit that the claims of the pending application are not obvious over the cited references of record.

Claim 17 includes additional distinctions over the documents cited in the Office action. Notably, claim 17 indicates that the slits are provided on an outside surface of the thick paper to insert corners of the photograph. The tabs of Ashcraft et al. are positioned on the inside of the frame to securely hold a display sheet. There is no disclosure or suggestion of slits for holding photographs on the outside of the store board. Accordingly, even if Ashcraft et al. were used to display a photograph, it is displayed on an inside surface of the frame. Therefore, for at least this reason as well, it is respectfully submitted that claim 17 is patentable over the documents cited in the Office action.

Applicants also maintain that the cited references fail to provide the requisite motivation to combine and modify the cited documents.

A determination of obviousness based on a combination of elements disclosed in the prior art must include some reference to a motivation, suggestion or teaching to combine the references. See, e.g., *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q. 2d (BNA) 1635, 1637 (Fed. Cir. 1998). The motivation, suggestion or teaching may come from the prior art, the knowledge of one skilled in the art or from the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q. 2d (BNA) 1614, 1617 (Fed. Cir. 1999). A finding of obviousness without particular findings as to the motivation or suggestion in the prior art for combining the references is an impermissible use of hindsight based on the Applicants' application. *In re Paulsen*, 31 U.S.P.Q. 2d 1671, 1676 (Fed. Cir. 1994) ("Multiple cited prior art references must

suggest the desirability of being combined, and the references must be viewed without the benefit of hindsight afforded by the disclosure.”).

The Office action indicates that it would have been obvious to combine the teachings of Lynton with that of Ashcraft to teach the invention as claimed. The proposed motivation for combining the references is to provide a method of mounting the substrate in a stable position. Applicants respectfully submit that the necessary motivation to combine these references is not present. The motivation to combine must be “clear and particular” and in the present case the purported motivation is neither.

Specifically, one of ordinary skill in the art at the time of the present invention would not have been motivated to combine Lynton with Ashcraft to teach the invention as claimed because the references fail to provide any motivation to make the proposed combination. Furthermore, applicants submit that the two references are not properly combinable. One of skill in the art reading the Lynton reference would not be motivated to combine Lynton with Ashcraft’s method for supporting a display sheet in a stable position.

Lynton is directed to a protective cover for sheets disposed within a looseleaf binder or scrapbook. Ashcraft et al., by contrast, describes a display sheet on the front cover of a binder. Although both documents relate to binders in general, the specific uses are entirely different and one of skill in the art would not look to one to modify the other. Accordingly, applicants respectfully submit that the documents cited fail to supply the requisite motivation to combine and modify the teachings to arrive at the present invention.

To establish a *prima facie* case of obviousness there must be some motivation or suggestion in the references that would lead one of ordinary skill in the art to combine the various components, without knowledge of the claimed invention, to obtain the present invention. *In re Kotzab*, 217 F. 3d 1365, 1371, 55 U.S.P. Q. 2d (BNA) 1313, 137 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with knowledge of the claimed invention, would have selected these components for combination in the manner claimed”). The mere identification of the various components in the prior art references is insufficient to render the present invention obvious. The motivation or suggestion “must be

considered in the context of the teaching of the entire reference.” *Id.* The references cited are devoid of any suggestion of picking and choosing various features of each reference to arrive at the present invention. One of skill in the art could never arrive at the present invention based on any motivation or suggestion in the references without the benefit of the applicants’ disclosure. Accordingly, applicants submit that the claims of the present application are not obvious over the combined teachings of the cited references.

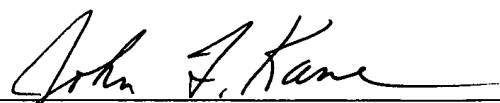
With respect to claim 1, the Office action indicates that patentability is based on the product and not on the process of making. Applicants submit that the store board and its structure are positively recited in the pending claims and this is a moot point.

With respect to claims 6 and 12 which recite color print portions having different colors corresponding to standardized photograph sizes, the Office action indicates that “the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability.” Applicants note that the color paper having color print portions is advantageous in that it provides an indication as to the proper slits to use for various size photographs. Furthermore, the presence of the color paper in the store board is advantageous in that it prevents contact between the corners or photographs inserted from each side of the store board.

In light of the foregoing response, it is respectfully submitted that claims 1-17, now pending, are patentably distinct from the references cited and are in condition for allowance.

Reconsideration and withdrawal of the rejections of record is respectfully requested. If the examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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